REMARKS

This Amendment is in response to the Office Action mailed on October 6, 2006. Claim 1 is amended editorially. Claims 17-20 are withdrawn. No new matter is added. Claims 1-16 remain pending.

Withdrawn Claims:

Claims 17-20 are withdrawn from consideration as drawn to a nonelected invention. Applicants request that claims 17-20 be retained for possible reinstatement upon allowance of claims 1-16.

Claim Objections:

Claims 1-16 were objected to for informalities. Claim 1 is amended to recite "provided on at least one side" as suggested by the Examiner. Withdrawal of this objection is requested.

§102(b) Rejections:

Claims 1-9 and 11-14 are rejected as anticipated by Suzuki (US Publication No. 2002/0037397). This rejection is traversed.

Claim 1 is directed to a member for a circuit board that requires, among other features, an electrically insulating material, a mold release film that is provided on at least one side of the electrically insulating material and the mold release film contains or is coated with a heat absorbing substance having a heat absorbing property. An advantage of these features is that they prevent the mold release film from contracting due to heat generated during laser processing before the film is removed from the electrically insulating material.

Suzuki does not disclose or teach or suggest these features. In particular, Suzuki fails to disclose or teach or suggest that the mold release film contains or is coated with a heat absorbing substance having a heat absorbing property. Suzuki is directed to a resin board for use as an insulating layer of a circuit board. Suzuki teaches a compression function layer (60) attached between the protective film layer (22) and the resin board (1) (see paragraph [0117]. Nowhere does Suzuki disclose or teach or suggest that the

protective film layer (22) contains or is coated with a heat absorbing substance having a heat absorbing property. In contrast, Suzuki merely discloses a compression function layer (60) made up of an insulating particle layer (32) and a resin board (1) (see paragraph [0061]). Moreover, the combination of the protective film layer (22) and the compression function layer (60) cannot be the mold release film of the present application as Suzuki only discloses that the protective film layer (22) may be removable (see paragraph [0117]). For at least these reasons, claim 1 is not anticipated by Suzuki and should be allowed. Claims 2-9 and 11-14 depend from claim 1 and should be allowable for at least the same reasons.

§102(e) Rejections:

Claims 1-14 are rejected as anticipated by Nakagiri (US Patent No. 7,045,198). This rejection is traversed.

As discussed above, claim 1 is directed to a member for a circuit board that requires, among other features, an electrically insulating material, a mold release film that is provided on at least one side of the electrically insulating material and the mold release film contains or is coated with a heat absorbing substance having a heat absorbing property. An advantage of these features is that they prevent the mold release film from contracting due to heat generated during laser processing before the film is removed from the electrically insulating material.

Nakagiri does not disclose or teach or suggest these features. In particular, Nakagiri fails to disclose or teach or suggest a mold release film that is provided on at least one side of the electrically insulating material. Nakagiri is directed to a prepreg and circuit board. Nakagiri teaches that a prepreg is impregnated with a filler-containing resin (see column 5, lines 30-47). Nowhere does Nakagiri disclose or teach or suggest a mold release film provided on at least one side of the electrically insulating material and that the mold release film contains or is coated with a heat absorbing substance having a heat absorbing property. For at least these reasons, claim 1 is not anticipated by Nakagiri and should be allowed. Claims 2-9 and 11-14 depend from claim 1 and should be allowable for at least the same reasons.

Claims 1-9 and 11-16 are rejected as anticipated by Nakamura (US Publication No. 2005/0005437). This rejection is traversed. The present application claims priority to JP Publication No. 2003-122834 filed in the Japanese Patent Office on April 25, 2003. Enclosed is a verified translation of the priority application.

The PCT application upon which Nakamura is based was published in Japanese, thus making the reference unavailable under amended 35 USC §102(e). The earliest prior art date of Nakamura is the earliest publication date of the underlying priority application, the PCT application or the US application. None of these can be earlier than the April 25, 2003 priority date of the parent application. Withdrawal of Nakamura as a prior art reference is requested.

Conclusion:

Applicants respectfully assert claims 1-16 are now in condition for allowance. If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Applicants' primary attorney-of record, Douglas P. Mueller (Reg. No. 30,300), at (612) 455-3804.

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PATENT TRADEMARK OFFICE

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Respectfully submitted,

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